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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,139	01/19/2001	Hisashi Yamagishi	Q61127	9352

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EXAMINER
HUNTER, ALVIN A

ART UNIT	PAPER NUMBER
3711	

DATE MAILED: 02/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/764,139	Applicant(s) YAMAGISHI ET AL.	
	Examiner Alvin A. Hunter	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 January 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. *09/129,883* .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4,6* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Comments

It is noted that the applicant has filed several applications, several of which are claiming conflicting subject matter, and at least three of which contain identical claims, which have necessitated the following rejections and which have not been brought to the attention of the examiner. The applicant and applicant's attorneys are respectfully reminded of their obligation to bring to the attention of the office those other applications which are material to the examination of this case.

Specification

1. The disclosure is objected to because of the following informalities: In line 10, of page 1, the word "provincial" should read –provisional--.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagishi et al. (USPN 5695413) in view of Yamagishi et al. (USPN 5779563) and OFFICIAL NOTICE.

Yamagishi et al. discloses a multi-layered golf ball having a two-layered core and cover (See Figure1). The inner core has a distortion of 3.5mm under an applied load of 100kg (See Figure 1). The cover layer has a Shore D hardness of 50 to 60 with a thickness of 1.3 to 2.4mm, and the outer core layer has a Shore D hardness of 20-70 with a thickness of 1.3 to 2.5mm (Figure 2). The product of the Shore D hardness of the outer core layer and cover would be 1000 to 4200 which is implied within Figure 2. Yamagishi et al. (USPN 5695413) does not disclose dimples. Yamagishi et al. discloses a plurality of dimples, at least three types of dimples different in diameter, in which the largest diameter is 4.150mm having a dimple depth of .210mm, Vo of .48, and the smallest dimple diameter is 3.5mm having a dimple depth of .210mm in order to improve flying distance, controllability, straight travel, roll, and durability (See Table 3, Type II). In addition, Yamagishi et al. discloses a Vo of 0.40 to 0.65 in order to prevent a stall and descending trajectory (See Column 5, lines 38 through 47).

OFFICIAL NOTICE is taken that varying the amount of dimples on a golf ball affects the flight performance of the golf ball; therefore, one having ordinary skill in the art in view of the OFFICIAL NOTICE would have been motivated to have any number of dimples, such as 370 to 450, for the purpose of routine optimization for obtaining the desired flight performance for the golf ball.

Therefore, it would have been obvious to include the ball of Yamagishi et al. (USPN 5695413) to have a Shore D product of 1000 to 4200 in order to have a ball that minimizes damage when being impacted by a club. In view of Yamagishi et al. (USPN 5779563), it would have been obvious to modify the ball of Yamagishi et al.

(USPN 5695413) to have type II dimples as defined by the claims in order to utilize a dimple pattern available in the market place to improve flying distance, controllability, straight travel, and roll.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claim 1 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of copending Application No. 09764316. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

4. Claim 1 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of copending Application No. 09764307. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 2-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 2-5 of copending Application No. 09764316. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application claims the same subject matter except for conditions 1, 3, 4, and 5 of Application No. 09764316. Application No. 09764316 clearly claims that the golf ball achieves the same if one of the conditions were satisfied; therefore, it would have been obvious to use any of the conditions claimed in Application No 09764316 to optimize the flight performance of the golf ball.

6. Claims 2-5 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-6 of copending Application No. 09764307. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application claims the same subject matter except for conditions 1, 2, 4, and 5 of Application No. 09764307. Application No. 09764307 clearly claims that the golf ball achieves the same if one of the conditions were satisfied; therefore, it would have been obvious to use any of the conditions claimed in Application No 09764307 to optimize the flight performance of the golf ball.

7. Claims 1-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-3 of copending Application No. 09511898. Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 09/511898 claims the same subject matter except for the VR ranges in conditions 1-3 which are slightly smaller than that of the present invention. It would be apparent that the invention would still achieve that of the present invention merely because there are common values that are claimed within the ranges of that claimed in the present application. It would have been obvious to one having ordinary skill in the art at the time the invention was made to a golf ball constructed to satisfy any of the conditions within Application No. 09511898 in order to achieve the desired flight performance of the golf ball through routine optimization. Furthermore, one having skill in the art would recognize that varying the number of dimples on a golf ball would affect the flight performance; therefore, it would have been obvious to construct a golf ball with any number of dimple for the purpose of routine optimization to achieve the desired flight performance of the golf ball.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 1-5 are provisionally rejected under the judicially created doctrine of double patenting over claims 3-16 of copending Application No. 09129883. Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 09129883 claims the same subject matter except having 370 to 450 dimples. One having ordinary skill in the art would recognize that varying the

number of dimples on a golf ball would affect the flight performance of the golf ball; therefore, it would have been obvious to construct a golf ball with any number of dimples for the purpose of routine optimization in order to achieve the desired flight performance.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is 703-306-5693. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell, can be reached on (703) 308-2126. The fax phone number for the organization where this application or proceeding is assigned is 703-308-7768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Paul T. Sewell
Supervisory Patent Examiner
Group 3700